

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IV. REMARKSRestriction RequirementRequest for Reconsideration to Establish Right of Petition

Applicant respectfully requests a reconsideration of the election requirement pursuant to CFR §1.143 to thereby establish right of petition on this matter.

Provisional Election with Traverse

In response to the restriction requirement set forth in the Office Action dated July 21, 2005, the claims of Group I (claims 1-7) are provisionally elected with traverse.

Restriction is proper only when (1) the restricted inventions are independent or patentably distinct, and (2) when there is a serious burden on the Examiner (MPEP 803). The burden is on the Examiner to provide reasons and/or examples in support of restriction (MPEP 803). Further, requirements to restrict should have two aspects: (1) the reasons why the inventions are independent/distinct, and (2) reasons for insisting upon restriction (MPEP 808).

The Examiner must provide reasons and/or examples to support conclusions.¹

The present Office Action has not provided reasons or examples. The sole rationale for imposing restriction onto Applicants' invention is set forth below:

In the instant case unpatentability of the group I invention would not necessarily imply unpatentability of the group II invention, since the device of the group I invention could be made by the processes materially different from those of the group II invention. (Office Action, dated 07/21/2005, Page 2, second full paragraph from the bottom).

The above provides is a conclusion, not a valid reason/example.

The MPEP guidelines illustrate this point in Section 806.05(f):

¹ MPEP §803.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Form paragraph 8.18 may be used in restriction requirements between product and process of making...

Inventions [1] and [2] are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §806.06(f)). In the instant case [3]...

... 2. In bracket 3, use one or more of the following reasons: ...

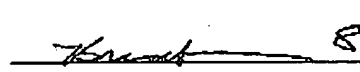
... --the product as claimed can be made by a materially different process such as--

It is clear that the "such as" indicates that an example is to be included meet the burden placed on the Examiner. Thus, absent the presentation of a viable example demonstrating distinctness the burden on the Examiner cannot have been met.

Accordingly, because the restriction requirement has provided no example, this requirement for restriction is traversed.

It is believed that the requirements for restriction have been traversed and the application may now be examined on the merits. Such action is respectfully requested.

Respectfully Submitted,

 8/16/05
Bradley T. Sako
Reg. No. 37,923

WALKER & SAKO, LLP
Bradley T. Sako
300 South First Street
Suite 235
San Jose, CA 95113
Tel. 1-408-289-5315